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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/891,929      | 06/26/2001  | Andreas Herpens      | Beiersdorf 722-KGB  | 3738             |

27384 7590 09/01/2004  
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EXAMINER

LAMM, MARINA

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1616

DATE MAILED: 09/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

## Application No.

09/891,929

## Applicant(s)

HERPENS ET AL.

## Examiner

Marina Lamm

## Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 18-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

Acknowledgment is made of the amendment filed 6/9/04. Claims pending are 18-47. Claims 18, 19, 22, 27 and 36 have been amended.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 19 and 21-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 19 and 21 as amended introduce new matter as they use the phrase "wherein the agent effective against the production of sebum is distarch phosphate and cyclodextrin". There is no support in the specification for the employment of the claimed combination of the agents. The limitation "distarch phosphate **and** cyclodextrin" was not described in the application as filed, and persons skilled in the art would not recognize in the applicant's disclosure a description of the invention as presently claimed. While describing the compositions containing either one of these agents, the specification does not describe or exemplify the claimed combination. Therefore, it is the examiner's position that the disclosure does not reasonably convey

that the inventor has possession of the subject matter of the amendment at the time of filing of the instant application.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 18, 20, 36-39 and 45-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Gettings et al. (US 4,908,355), of record.

Gettings et al. teach a method of treating skin disorders such as acne (which is an inflammatory disease of the sebaceous glands) by topically applying to the epidermis a composition containing a volatile silicone oil such as cyclomethicone or dimethicone, an abrasive such as talc, mica, starch, titanium dioxide, etc., and an astringent such as aluminum chlorohydrate, zirconium hydroxychloride and aluminum-zirconium salts. See Claims 1-3; col. 4, lines 41-59; col. 8, lines 18-68; col. 9, lines 1-52. The compositions of Gettings et al. include shampoo compositions. See Example I. The limitations of Claims 38, 39, 46 and 47 are inherent in the reference because the reference teaches the same method step, i.e. "topically applying a composition to an area affected by increased sebum production."

Thus, Gettings et al. teach each and every limitation of Claims 18, 20, 36-39 and 45-47.

***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 40-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gettings et al.

Gettings et al. applied as above. The reference does not explicitly teach the claimed concentration of the antiperspirant actives. However, the determination of optimal or workable concentration of the antiperspirant actives by routine experimentation is obvious and within the skill of the art. One having ordinary skill in the art would have been motivated to do this to obtain the desired astringent properties of the composition. Further, there appears to be no criticality in the claimed concentration since the prior art recognizes and obtains the same acne treating effect.

7. Claims 19 and 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gettings et al. in view of Müller et al. (WO 98/01109) as translated by Müller et al. (US 6,248,338) and Dodd et al. (US 6,656,456), all of record.

Gettings et al. applied as above. Further, Gettings et al. teach that acne is accompanied by "microbially generated odors". See col. 3, line 42. The reference does not explicitly teach distarch phosphate and cyclodextrin of the instant claims. However, Müller et al. teach using distarch phosphate in skin or hair care composition as stability improver, as a viscosity regulator, as a (co)emulsifier and as an agent for improving skin feel and increasing water retention capacity of the skin. See col. 3, lines 27-28; col.

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5, lines 23-65. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the composition of Gettings et al. such that to employ distarch phosphate. One having ordinary skill in the art would have been motivated to do this to obtain compositions having improved stability, good skin feel and moisturizing effect as suggested by Müller et al. Further, Dodd et al. teach skin deodorizing compositions containing cyclodextrin as an odor control agent. See col. 4, lines 1-16. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the composition of Gettings et al. such that to employ cyclodextrin. One having ordinary skill in the art would have been motivated to do this to obtain compositions having improved odor control as suggested by Dodd et al. With respect to Claims 23-26, which recite the concentration of the antiperspirant active, it is the Examiner's opinion that the determination of optimal or workable concentration of the antiperspirant actives by routine experimentation is obvious and within the skill of the art. One having ordinary skill in the art would have been motivated to do this to obtain the desired astringent properties of the composition. Further, there appears to be no criticality in the claimed concentration since the prior art recognizes and obtains the same acne treating effect.

8. Claims 27-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gettings et al. in view of Kropf et al. (US 6,316,030), of record.

Gettings et al. applied as above. Gettings et al. do not explicitly teach the claimed aluminum hydroxylactate. However, Kropf et al. teach using aluminum

hydroxylactate as a antiperspirant conventionally used in perspiration-inhibiting compositions for the same purpose as aluminum chlorohydrate. See col. 7, lines 20-36. Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to use aluminum hydroxylactate of Kropf et al. in compositions of Gettings et al. with a reasonable expectation of achieving the same astringent effect because aluminum hydroxylactate of Kropf et al. is a known astringent/antiperspirant salt commonly used for the same art-recognized purpose as aluminum chlorohydrate of Gettings et al. Selection of a known material based on its suitability for its intended use is obvious absent a clear showing of unexpected results attributable to the applicant's specific selection. See e.g., *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). With respect to Claims 31-35, which recite the concentration of the antiperspirant active, it is the Examiner's opinion that the determination of optimal or workable concentration of the antiperspirant actives by routine experimentation is obvious and within the skill of the art. One having ordinary skill in the art would have been motivated to do this to obtain the desired astringent properties of the composition.

### ***Response to Arguments***

9. Applicant's arguments with respect to claims 18-47 have been considered but are moot in view of the new ground(s) of rejection. See above.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (571) 272-0618. The examiner can normally be reached on Mon-Fri from 11am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached at (571) 272-0887.


The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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8/27/04

  
MICHAEL G. HARTLEY  
PRIMARY EXAMINER